

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of : Docket No.: 6161.0070.US
Yong-Tae KIM, *et al.* : Confirmation No.: 4172
Application No.: 10/664,157 : Group Art Unit: 1745
Filed: September 17, 2003 : Examiner: CHU, Helen Ok
For: **NEGATIVE ELECTRODE FOR LITHIUM BATTERY AND LITHIUM BATTERY
COMPRISING SAME**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Sir:

In reply to the August 24, 2006, Restriction Requirement, Applicants provisionally elect Group I, including claims 1-25, drawn to a method of fabricating a negative electrode, classified in class 429, subclass 215, with traverse.

Applicants respectfully traverse and wish to place the application in better condition to appeal the restriction requirement.

The Examiner has stated:

"Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25, drawn to a method of fabricating a negative electrode, classified in class 429, subclass 215.
- II. Claims 26-34, drawn to a method of fabricating a negative electrode, classified in class 429, subclass 209.
- III. Claims 35-38, drawn to a lithium battery, classified in class 429, various classes.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different

product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. Specifically, the electrode does not require a slurry mixture as a process step. The electrode can be made by dipping the lithium metal filled with organosulfur into the solvent.

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed can have a negative electrode without an organosulfur protective layer. The subcombination has separate utility such as the subcombination can be used in a fuel cell.

The foreword to the MPEP states, in relevant part: "The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations." What 35 U.S.C. 121, the law, states in relevant part: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct." The Examiner has only argued that the inventions are distinct. The Examiner has not also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicants request that it be withdrawn.

Note that Applicants do not consider the following explanation of the meaning of "independent" and "distinct" in MPEP § 802.01 persuasive:

802.01 Meaning of "Independent" and "Distinct" [R-3]

35 U.S.C. 121 quoted in the preceding section states that the *>Director< may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the *>inventions< as between which the *>Director< may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that **35 U.S.C. 121**: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the *>inventions< between which the *>Director< may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of *>inventions< between which, prior to the 1952 Act, division had been proper, are dependent *>inventions<, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the *>Director< never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the *>Director< has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

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I. < INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more **>inventions claimed<, that is, they are unconnected in design, operation, *>and< effect*>. For< example **, a< process and >an< apparatus incapable of being used in practicing the process* >are independent inventions. See also **MPEP § 806.06** and **§ 808.01**.

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II. < DISTINCT

**>Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture),

operation (e.g., function or method of use), or effect. Examples of related inventions include combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. **>In this definition the term related is used as an alternative for dependent in referring to *>inventions< other than independent *>inventions<.

>Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05() (related products or related processes) for examples of when a two-way test is required for distinctness.<

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

The arguments presented in the MPEP seem to rest on two pillars:

1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicants submit that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." *Connecticut Nat'l Bank v. Germain*, 112 S. Ct. 1146, 1149 (1992). Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'" *Id.*

2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, yet MPEP § 802.01 concedes that that they do have different definitions and helpfully provides them.

Therefore, the applicants suggest that the Examiner has not satisfied 35 U.S.C 121 in the restriction requirement. If the Examiner wishes to maintain the restriction requirement, the applicants respectfully request that the Examiner also explain how the subject matter represents

two “independent” inventions, according to the definition of “independent” given in MPEP § 802.01.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

It is not believed that any extensions of time or fees are required. If extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. §1.136(a) and are hereby authorized to be charged to our **Deposit Account No. 50-3698 (H.C. Park & Associates, PLC).**

Respectfully submitted,

/hae-chan park/

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